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KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082			FIDEI, DAVID	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/090,885

**MAILED**

Filing Date: March 04, 2002

**MAY 05 2005**

Appellant(s): BROWN, DEAN R.

**Group 3700**

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Paul John Parins  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 17, 2005.

**(1)     *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2)     *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3)     *Status of Claims***

This appeal involves claims 1-10.

**(4)     *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5)     *Summary of Invention***

The summary of invention contained in the brief substantially reflects the claimed subject matter. On page 9 of the brief, appellant states the shrinkwrap layer can be replaced over the lid to help reseal the container after it has been initially opened. Nothing is recited in the claims setting forth a shrinkwrap that covers the entire lid (claim 2 recites the shrinkwrap is formed to at least a portion of the lid) nor is anything set forth in the claims concerning the shrinkwrap being replaced over the lid to help reseal the container after it has been initially opened. Appellants' explanation of the invention in this capacity is not germane to the claimed subject.

**(6)     *Issues***

The appellant's statement of the issues in the brief is incorrect. The rejections presented in the Non-Final Office Action mailed October 10, 2003 are moot. It is submitted the Final Rejection mailed May 11, 2004 makes clear the issues along with the standing grounds of rejections applied in this case.

**(7) *Grouping of Rejections***

Appellant's brief includes a statement and arguments over rejections applied in the Non-Final Office Action mailed October 10, 2003. Since the claims have been amended with different grounds of rejection applied in the Final Rejection, those arguments are considered moot.

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

3,976,795	Ando	8-1976
4,102,454	Karevaara	7-1978
5,605,230	Marino, Jr. et al.	2-1997
5,489,126	Gray, Jr.	2-1996
6,247,612	Kaufman	6-2001

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

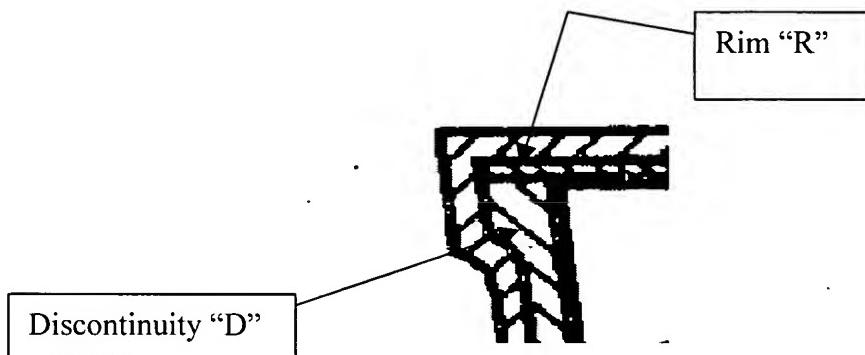
Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on May 11, 2004.

Claims 1-10 rejected under 35 U.S.C.103. This rejection is set forth in a prior Office Action, mailed on May 11, 2004.

**(11) *Response to Argument***

I] With regard to rejection of claims 1, 2, 6 and 7 lacking novelty under 35 U.S.C. 102(b), Ando contains all of the elements recited in the above claims.

Ando discloses a container (1) for storing items, comprising: a container bottom; a side wall extending upward from said bottom and terminating in a rim (R, shown below defined as that planar surface where the lid attaches to the container) defining the periphery of said container, said side wall tapering from top to bottom; a lid (5) covering said container; a surface discontinuity (D, shown below) disposed on said side wall intermediate said rim and said container bottom; and a layer of shrinkwrap (7).



The shrinkwrap film of Ando is described as heat contracted to such a degree that it adheres airtight to the container 1, see col. 3, lines 6-8. Hence, the layer of shrinkwrap is formed to and clings to at least a portion of said tapered side wall, wherein said layer of shrinkwrap is formed to and covers said surface discontinuity and conforms to the shape thereof.

In this regard appellant argues Ando fails to disclose a surface discontinuity disposed on the tapered sidewall intermediate the rim and bottom of the container that helps hold the shrink wrap in position against the tapered sidewall, page 12 of appellants' brief. It is not seen where claim 1 recites such a limitation. Claim 1 recites "a surface discontinuity disposed on said side wall intermediate said rim and said container bottom; and a layer of shrinkwrap, wherein said layer of shrinkwrap is formed to and clings to at least a portion of the said tapered side wall, wherein said layer of shrinkwrap is formed to and covers said surface discontinuity and conforms to the shape thereof". Which is what Ando discloses to the extent claimed.

Nowhere does Ando state the above discontinuity helps hold the shrinkwrap in position, however, such a burden is nor required of the Examiner to show anticipation. The law of anticipation does not require that the reference teach what applicant has disclosed, but only that the claims "read on" something disclosed in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 281 USPQ 871 (Fed. Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim as a reference must disclose the claimed subject matter expressly or inherently, *Constant v. Advanced Microwave Devices, Inc.*, 7 USPQ2d 1057 (Fed. Cir. 1989).

If the surface discontinuity of Ando would not help hold the shrinkwrap in place, then it is submitted the claims have not recited enough of structure to fulfill this function since Ando discloses as much structure as is recited in the claim and yet fails, allegedly according to appellant, to meet the advantages recited in claims 1, 2, 6 and 7. The Examiner would also point out appellants' entire basis of Andos' surface discontinuity allegedly failing to hold the shrinkwrap in place centers around the film being removed, see page 13, third full paragraph of the brief. *Which is not germane to claims 1, 2, 6 and 7.* Accordingly, it is respectfully requested the rejection of claims as being anticipated over Ando be maintained.

(II) With regard to rejection of claims 1, 2 and 6-10 being obvious under 35 U.S.C. 103, over Ando in view of Karevara, appellant acknowledges Karevara discloses surface discontinuities to prevent undesirable tilting and frictional fit in a stack of handled mugs. However, it is argued Karevara fails to cure the deficiencies of Ando in suggesting a surface discontinuity that helps hold a layer of shrinkwrap in position against the tapered sidewall. The fact that applicant may have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It would have been obvious to one of ordinary skill in the art to modify the relatively smooth sidewall surface of Ando by constructing a plurality of indentations disposed on the side

wall, wherein said indentation comprises a ridge extending continuously around said container side wall as taught by Karevara, in order to facilitate separation when stacking the containers in storage or transportation prior to filling with the food product. The motivation for this combination are surfaces discontinuities provide an air space between containers when they are vertically stacked. Stacking occurring for storage or transportation of containers to a designated source. Stacking can also occur in packaging filling machines or stations. This air space inhibits similarly stacked containers from sticking together when they are separated.

Appellant asks why would one skilled in the container for storing foodstuff would be concerned with the stacking challenges of Karevara? Particular when foodstuff are not in drinking containers. It is not seen what this has to do with what the references, taken as a whole, would suggest to skilled in the art.

One does not drink foodstuff? Soup and other food containers are conventionally made into cup-like containers. Even where soup is consumed like a beverage. In fact a popular brand directly draws such a correlation in their brand name Cup O Noodles (emphasis mine). It would be myopic to presume the two fields are not related or that one skilled in the art of dehydrated food disposable containers would have no knowledge of disposable cups. As such, it is equally argued it would have been obvious to one of ordinary skill in the art to provide the structure of Karevara also for the advantages of providing the container of Ando with a handle. The handle also performs a holding function where the hot contents can be easily handled.

Accordingly, it is submitted to modify Ando by providing the indentations if not obvious for stacking would have been *prima facie obvious* for the reason of equipping the container with a handle to facilitate holding and handling of the hot contents.

(III) With regard to claim 3 being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Marino, Jr. et al, appellant argues Marino, Jr. et al fails to cure the deficiencies of Ando and Karevara. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

While it appears the container of Marion Jr. et al does not have a side wall which tapers from top to bottom, it is not seen what this has to do with the subject matter of claim 3. Ando clearly discloses a container having a sidewall tapering from top to bottom in combination with a shrinkwrap. Claim 3 recites specific features of the shrinkwrap, wherein said shrinkwrap layer further comprises a tear originating at a top portion thereof and extending downward along said side wall, said shrinkwrap layer being substantially separated from said lid and rim yet substantially clinging to said side wall, whereby said lid can be opened or removed yet said shrinkwrap layer clings to said side wall.

If Marion Jr. et al where required to have all of the features of claims 1 and 2, from which claim 3 depends, in order to render obvious the claimed invention then there would be no scenario 35 U.S.C. 103 would ever be applicable. However, such is not the law.

Marino, Jr. et al teaches a shrinkwrap sleeve 24 that also includes a vertical line of perforations 26a for separation of the removed upper portion 24a of the sleeve 24 from the cap 20. Upon removal of the upper portion 24a of sleeve 24, the lower sleeve portion 26a remains on the base 14, covering the label 22. Removal of the upper portion 24a also exposes the cap so that it may be removed for access to the inside of the bottle 12, see col. 2, lines 49-54. It would have been obvious to one of ordinary skill in the art to modify the film 7 of Ando (Patent no. 3,976,795) by constructing a tear originating at a top portion thereof and extending downward along said side wall, said shrinkwrap layer being substantially separated from said lid and rim yet substantially clinging to said side wall, whereby said lid can be opened or removed yet said shrinkwrap layer clings to said side wall as taught by Marino Jr. et al. The motivation for the combination is to facilitate opening of the container by at least partial removal of the film. Accordingly, it is respectfully requested the rejection of claim 3 as being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Marino, Jr. et al be maintained.

(IV) With regard to claim 4 being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Gray Jr., appellant again argues Gray, Jr. et al fails to cure the deficiencies of Ando and Karevara. As noted previously, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references.

Gray Jr. relates to the shrink wrap and packaging art are where a dual function of the shrink wrap not only protects the underlying article but also provides a means for attaching a label. Likewise it would have been obvious to one of ordinary skill in the art to construct the container of Ando with an adhesive free label as taught by Gray, for the reason of providing a product identification such as a bar code.

Accordingly, it is respectfully requested the rejection of claim 4 as being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Gray, Jr. et al be maintained.

(IV) With regard to claims 4 and 5 being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Kaufman, appellant again argues Kaufman et al fails to cure the deficiencies of Ando and Karevara with respect to claim 1. Appellant notes Kaufman relates to dispensable promotional items apparently having adhesive free labels (col. 4, lines 29-41) and adhesively affixed labels (col. 6, line 58) on page 19 of the brief, referring to the Final Rejection. However, as noted previously one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

While it appears the container of Kaufman does not have a side wall which tapers from top to bottom in figures 2, 4 or 6, it is not seen what this has to do with the subject matter of claims 4 and 5. A shrink wrap 42 is disclosed where Kaufman teaches placing a label 44 there under. In col. 6, lines 58 to col. 7, line 5 an embodiment is disclosed where the label is adhesively attached to the bottle, attached by transparent adhesive tape (i.e. a label adhesively attached to the outside layer), formed by a label wrapped around the outside of the shrink wrap or the shrink wrap is printed to have the label information. All of which appear to be obvious variants for associating a label with a shrink wrap.

As set forth in the Final Rejection, it would have been obvious to one of ordinary skill in the art to modify the container of Ando by employing an adhesive-free label disposed between said shrinkwrap layer and said container side wall, said shrinkwrap layer holding said label in

place as taught by Kaufman. Or in the alternative, it would have been equally obvious to one of ordinary skill in the art to provide a label adhesively affixed to the outside of said shrinkwrap layer about said side wall as is also taught by Kaufman. The motivation for this combination is to provide product information, advertisement, coupons, logo's, directions for use, prizes or any of myriad of known uses to those skilled in the packaging art. Ando lacks any teaching of how the food product is identified. Also, logo's or indicia provide the consumer with rapid product identification thus enhancing the desirability of buying a product. One skilled in the art would have found it highly desirability, if not practically necessary, to associate a label with the product of Ando. Providing a label either underneath or on the film 7 represents nothing novel in the art.

Since a label underneath the film would be held by the film and some type of attachment would be required to make the label adhere to the outside of the film, the requirements of adhesive-free or adhesive is not viewed as defining an unobvious difference. Rather it would be well within the level of ordinary skill to provide an inside label adhesive-free while the outside label includes an adhesive. The level of ordinary skill determined by the prior art of record where it is shown to provide adhesive to attach labels and adhesive-free labels are known for its use in conjunction with shrinkwrap.

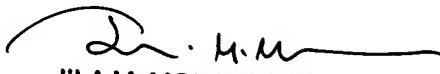
Accordingly, it is respectfully requested the rejection of claims 4 and 5 as being unpatentable over under 35 U.S.C. 103, over Ando in view of Karevara and further in view of Kaufman be maintained as appellants' arguments provides nothing to convince one otherwise.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,  
  
David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
May 3, 2005

Conferees

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700  
JILA M. MOHANDESI  
PRIMARY EXAMINER

KAGAN BINDER, PLLC  
SUITE 200, MAPLE ISLAND BUILDING  
221 MAIN STREET NORTH  
STILLWATER, MN 55082